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September 28, 2005
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Leverage Group, Inc.

Serial No. 78229210

Karin Segall and Heather C. Wilde of Darby & Darby P.C. for The Leverage Group, Inc.

Rebecca L. Gilbert, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Quinn, Hohein and Zervas, Administrative Trademark Judges.
Opinion by Hohein, Administrative Trademark Judge:

The Leverage Group, Inc. has filed an application to register on the Principal Register the mark "THE LEVERAGE GROUP" for "business marketing consulting services in the nature of promoting the goods and services of others by creating strategic partnerships between entertainment entities and business entities and arranging for sponsorships between entertainment entities, business entities and entities seeking to promote public causes" in International Class 35.¹

¹ Ser. No. 78229210, filed on March 24, 2003, which is based on an allegation of a date of first use anywhere and in commerce of May 1, 1998; the word "GROUP" is disclaimed.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its services, so resembles the mark "LEVERAGE ENTERPRISES," which is registered on the Principal Register for "business management consultation, market research analysis and strategic business planning" services in International Class 35,² as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the services or goods at issue and the similarity or dissimilarity of the respective marks in their entirety.³

² Reg. No. 2,427,789, issued on February 13, 2001, which sets forth a date of first use anywhere and in commerce of January 31, 1998; the word "ENTERPRISES" is disclaimed.

³ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the [services or] goods and differences in the marks." 192 USPQ at 29.

Turning first to consideration of the respective services, applicant notes that it made of record "material from both its website and that of the registrant demonstrating the type of services each ... offers and the prospective customers for those services." Besides contending, in view thereof, that the respective services are in fact very different, applicant also asserts that the related *du Pont* factor of the conditions under which and buyers to whom sales are made, that is, "impulse" versus careful, sophisticated purchasing, "is highly relevant here," arguing that:

Specifically, Applicant submitted evidence from its website demonstrating that its services are focused on building strategic alliances between companies, such as establishing product placements for a specific manufacturer in a film or arranging a mutually beneficial arrangement between two businesses, such as a credit card company and retail stores or a joint promotion between a health food company and a health club. Applicant's website also shows that Applicant arranges for sponsorships between for-profit companies and organizations seeking to promote public awareness of a health or social issue, such as breast cancer, children's health and education.

The registrant's website states that Leverage Enterprises provides "environmental program development support to private, government and non-profit clients worldwide. We occupy the business niche where environmental science and business development intersect."

This evidence clearly demonstrates the differences between the ... services and the potential customers for those services.

Moreover, Applicant's services are expensive, costing tens of thousands of

dollars and even more, depending on the nature of the project. Not surprisingly, therefore, Applicant's customers are large companies who pay retainers of approximately \$15,000 per month. Obviously, Applicant's services are not impulse purchases. The relevant consumers are likely to be extremely careful in their selection process and unlikely to be confused.

Additionally, both ... services are directed towards educated, sophisticated consumers. Their respective consumers need to learn about the services, have multiple discussions with the respective service providers and have continuing relationships with the service provider.

The Examining Attorney, on the other hand, insists in her brief that "applicant's and registrant's services both overlap and are complimentary [sic]" in that registrant's "'strategic business planning' encompasses planning strategic business partnerships, such as those applicant creates," while "registrant's 'market research analysis' encompasses research analysis about all markets, including the markets applicant targets." In addition, the Examining Attorney maintains that:

Applicant argues at length that it has submitted evidence to establish that the users and fields of the respective services differ, and that registrant's services relate to environmental science. However, this argument is not relevant or permissible Applicant may not unilaterally limit the scope of a valid federal trademark registration. Further, likelihood of confusion is determined on the basis of the goods or services as they are identified in the application and registration. *Canadian Imperial Bank of Commerce[, N.A.] v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973). Since the identification of the registrant's services is very broad, it is presumed that the

registration encompasses all services of the type described, including those in the applicant's more specific identification, that they move in all normal channels of trade and that they are available to all potential consumers. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re Optica International*, 196 USPQ 775 (TTAB 1977); TMEP §1207.01(a)(iii). Therefore, it must be concluded that registrant's strategic business planning and market research analysis involve all fields of use, including those related to strategic business partnerships in applicant's specific fields.
....

Applicant's argument that its services are expensive and its customers sophisticated is not dispositive. The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. See *In re Decombe*, 9 USPQ 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983); TMEP §1207.01(d)(vii).

It is well settled, as correctly noted by the Examining Attorney, that the issue of likelihood of confusion must be determined on the basis of the services or goods as they are respectively set forth in the particular application and the cited registration, and not in light of what such services or goods are asserted to actually be. See, e.g., *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, supra at 1815-16; *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, supra at 77. Thus, where the services or goods in the

application at issue and in the cited registration are broadly described as to their nature and type, such that there is an absence of any restriction as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that in scope the identification of services or goods encompasses not only all services or goods of the nature and type described therein, but that the identified services or goods are provided in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof. See, e.g., In re Elbaum, supra.

Here, it is clear that, as identified, applicant's "business marketing consulting services in the nature of promoting the goods and services of others by creating strategic partnerships between entertainment entities and business entities and arranging for sponsorships between entertainment entities, business entities and entities seeking to promote public causes" are on their face identical in part and otherwise commercially related to registrant's "business management consultation, market research analysis and strategic business planning" services. In particular, as accurately observed by the Examining Attorney, registrant's "strategic business planning" services are identified so broadly as to include applicant's services of "promoting the goods and services of others by creating strategic partnerships between entertainment entities and business entities." Business and entertainment entities, therefore, would plainly be purchasers of applicant's and registrant's services. Consequently, as identified, not only would the services at issue

herein be rendered to or used by the same classes of client customers, but such services would necessarily be advertised and sold through identical channels of trade. If such services were to be rendered under the same or similar marks, confusion as to the source or sponsorship thereof would be likely to occur, notwithstanding the sophistication of the clients who would utilize applicant's and registrant's services.

Specifically, given the client interaction which is inherent in both applicant's business marketing consulting services for promoting the goods and services of others through the creation of strategic partnerships and registrant's identical in part and otherwise commercially related business management consulting, market research analysis and strategic business planning services, customers therefor would no doubt be sophisticated in that they would be knowledgeable as to their anticipated needs or goals and would select such services only after careful consideration. Nonetheless, it is well settled, as properly noted by the Examining Attorney, that the fact that business and entertainment entities, as clients for the respective services, may be expected to exercise deliberation in their choice of such services "does not necessarily preclude their mistaking one trademark [or service mark] for another" or that they otherwise are entirely immune from confusion as to source or sponsorship. *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). See also *In re Decombe*, supra at 1814-15; and *In re Pellerin Milnor Corp.*, supra at 560. Clearly, the more similar the marks at issue, the more likely

confusion becomes even for discriminating and sophisticated customers.

Turning, therefore, to consideration of the respective marks, applicant argues that because of the differences therein, confusion is not likely. Applicant, in this regard, points out that the respective marks differ in sound and appearance in that, aurally, "THE LEVERAGE GROUP is a three word, five syllable mark" while, by contrast, "LEVERAGE ENTERPRISES is a two word, seven syllable mark." Visually, applicant observes that while its mark "is comprised of three words and sixteen letters," registrant's mark "is comprised of two words and nineteen letters." Both marks, applicant contends, "share only the term 'leverage,' consisting of only eight letters and representing less than half of either mark." Applicant further maintains that "[t]he mere fact that both marks contain the term 'leverage' is, in any event, insufficient to render confusion likely in view of the differences in the remainder of the ... marks." Moreover, in terms of their commercial impression and connotation, applicant asserts that (footnote omitted):

Looking ... at the commercial impressions of the marks, Applicant's THE LEVERAGE GROUP mark is intended to suggest the nature of Applicant's services. Applicant is in the business of assembling or "grouping" together companies for their mutual benefit. The mark LEVERAGE ENTERPRISES conveys a more technical, business impression. Applicant submitted evidence [from www.dictionary.com] showing that an enterprise is defined [by The American Heritage Dictionary of the English Language (4th ed. 2000)] as "an undertaking, especially one of some scope, complication, and risk; a business organization" among

other things. The evidence of record shows that LEVERAGE ENTERPRISES is a woman-owned business occupying "the business niche where environmental science and business development intersect." Thus, LEVERAGE ENTERPRISES conveys the idea both that the company is an enterprise and that it is enterprising. Neither impression is conveyed by the mark THE LEVERAGE GROUP.

In addition, applicant urges that "the Examining Attorney improperly discounted the additional elements of each mark, particularly in light of the weakness of the term 'leverage.'" As support for its assertion of the weakness of the respective marks, applicant notes that it made of record copies of third-party registrations for the following marks and services: (i) "CLEARLEVERAGE" for "consulting services in the field of sales and marketing for law firms" (Reg. No. 2,818,995, issued on March 2, 2004); (ii) "CORE LEVERAGE" for "business consultation, market research services and developing promotional campaign for businesses, namely, identification of services of competitive advantages of a business client" (Reg. No. 2,176,775, issued on July 28, 1998); (iii) "LEGAL LEVERAGE" for, *inter alia*, "providing information in the field of business and business consulting" (Reg. No. 2,597,176, issued on July 23, 2003); (iv) "DESIGN LEVERAGE" ("DESIGN" disclaimed) for "providing business consulting services to others for formulating a strategy for utilization of graphic design, architecture, industrial design, corporate identity and functional design to achieve a unique positional advantage in the marketplace" (Reg. No. 2,919,599, issued on January 18, 2005); (v) "MARKETING LEVERAGE, INC." (in stylized form) for "consulting services in the field of

marketing, namely analyzing market conditions for a client, evaluating the client organization and providing advice in these related areas" (Reg. No. 1,552,387, issued on August 15, 1989); and (vi) MANAGEMENT LEVERAGE, INC." ("MANAGEMENT" and "INC." disclaimed) for "management consulting services" (Reg. No. 1,477,170, issued on February 16, 1988). Applicant argues, in view thereof, that (citations omitted):

The co-existence of several registrations for marks incorporating the term "leverage" covering business consulting services is relevant to show that [that] term is so commonly used that the public will look to other elements to distinguish the source of the ... services. Here, each party's mark incorporates additional elements, namely, the terms "group" and "enterprise." Giving due weigh [sic] to these non-similar elements, considering weakness of the term "leverage" and comparing the marks in their entireties ... the marks are readily distinguishable.

Finally, applicant claims that the length of time during and conditions under which there has been contemporaneous use of the marks at issue without evidence of actual confusion is another factor weighing in favor of a finding of no likelihood of confusion. Applicant stresses in this regard that its "mark and the cited mark have been in concurrent use for nearly seven years without any instances of actual confusion." Referring, in particular, to copies of excerpts which it made of record from its website and that of the registrant, applicant asserts that "[m]uch of that concurrent use has taken place on a national scale as both parties offer their respective services through Internet websites."

The Examining Attorney, on the other hand, insists in her brief that (footnote and some citations omitted):

The marks share the dominant feature LEVERAGE. Applicant has added THE and the disclaimed word GROUP. The cited registered mark includes the disclaimed descriptive word ENTERPRISES. Applicant argues that the addition of these descriptive disclaimed words significantly alters the commercial impression of the ... respective marks. However, it is well established that disclaimed matter is typically less significant or less dominant when comparing marks. Although a disclaimed portion of mark certainly cannot be ignored, and the marks must be compared in their entireties, one feature of a mark may be more significant in creating a commercial impression. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997) (holding that DELTA is the dominant portion of the mark THE DELTA CAFÉ where the disclaimed word "café" is descriptive of applicant's services); *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987). In the instant case, LEVERAGE is the dominant feature of the ... marks and the addition of GROUP and ENTERPRISES does not significantly alter the commercial impression of the marks. In fact, if anything, these terms actually strengthen the similarity between the marks because they have a highly similar meaning. As applicant's definition shows, an enterprise is "a business organization". An "organization" [as defined by The American Heritage Dictionary of the English Language (3d ed. 1992)] is: 4. A group of persons organized for a particular purpose[.]

Thus, the impression of the marks is LEVERAGE as the name of the entity, with GROUP and ENTERPRISES merely describing that the services are provided by a collective, a group. Applicant's argument that registrant's mark "conveys a more technical, business impression" is not supported by fact or by definition. Moreover, the fact that registrant is "woman owned" does not alter the impression of the registered mark, and

does not, therefore, limit its scope of protection. Further, applicant's arguments about the number of syllables and letters in the marks is not persuasive. The extra letters and syllables do not alter the commercial impression of the marks.

With respect to applicant's contention that the term "LEVERAGE" is a weak element, the Examining Attorney argues that "[t]he existence of a handful of third[-]party registrations containing the term LEVERAGE is not a persuasive factor in establishing that the mark LEVERAGE ENTERPRISES is so weak that it should be entitled to little protection." As the Examining Attorney correctly points out:

Third-party registrations, by themselves, are entitled to little weight on the question of likelihood of confusion. *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983). Third-party registrations are not evidence of what happens in the marketplace or that the public is familiar with the use of those marks. *National Aeronautics and Space Administration v. Record Chemical Co.*, 185 USPQ 563 (TTAB 1975).

Moreover, as to the marks at issue herein, the Examining Attorney accurately observes that their "structure and overall impression" are "much more similar than those in the third[-]party registrations."

Finally, citing *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990), and cases cited therein, the Examining Attorney urges that "applicant's argument that there is no evidence of actual confusion is not convincing" because the test under Section 2(d) of the Trademark Act is whether there is a likelihood of confusion and, hence, it is unnecessary to show actual confusion.

The Examining Attorney also notes that, as stated in *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984), an "applicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from"

We agree with the Examining Attorney that, when considered in their entirety, applicant's mark "THE LEVERAGE GROUP" so resembles registrant's mark "LEVERAGE ENTERPRISES" that the contemporaneous use thereof in connection with their respective services would be likely to cause confusion as to the origin or affiliation thereof. In particular, we concur with the Examining Attorney that the marks at issue are similar in sound and appearance, in view of the shared term "LEVERAGE," and that each mark is dominated by such term, due to the descriptiveness of the words "GROUP" and "ENTERPRISES."

Moreover, while the Examining Attorney is correct that the third-party registrations relied upon by applicant do not demonstrate use of such marks in the marketplace or that the consuming public is familiar with the use of those marks and has learned to distinguish between them, see, e.g., *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973); and *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d

1403, 177 USPQ 268, 269 (CCPA 1973), such registrations may nonetheless be properly given some weight to show the meaning of a mark in the same way that dictionary definitions would be so used. See, e.g., Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976). Here, the registrations are sufficient to demonstrate that the term "LEVERAGE" has been adopted by third parties in connection with various business consultation services for its suggestive meaning. However, notwithstanding the suggestiveness of such term, the combination thereof with the words "GROUP" and "ENTERPRISES" is not sufficient to create marks which are dissimilar enough to be distinguishable. Rather, given the similarity in connotation of the words "GROUP" and "ENTERPRISES," applicant's "THE LEVERAGE GROUP" mark and registrant's "LEVERAGE ENTERPRISES" mark are so substantially similar in connotation and overall commercial impression that the contemporaneous use thereof would be likely to cause confusion as to source or sponsorship. As applicant acknowledged in its response to the initial Office action, "both marks convey the idea of leveraging what you have to get more."

Turning, as a final consideration, to applicant's claim that its "mark and the cited mark have been in concurrent use for nearly seven years without any instances of actual confusion," the sole evidence pertaining thereto, in light of applicant's assertion that "[m]uch of that concurrent use has taken place on a national scale as both parties offer their respective services through Internet websites," consists of printouts of a few excerpts from such websites. Among other things, it is noted

that registrant's website indicates that registrant "is a small, woman-owned business" based in Madison, Virginia which occupies "the business niche where environmental science and business development intersect" with a focus on procurement contracts in "the ever-changing federal marketplace." Registrant's clients include "firms selling environmental and engineering services to the US federal government" and those which "provide support to federal government programs in a number of technical and support areas." Applicant's website, in contrast, refers to applicant as "a global marketing consulting firm based in New York and Los Angeles" which "specialize[s] in creating strategic alliances for corporations, entertainment entities and non-profit organizations." Applicant's clients include "Fortune 500, consumer product and financial services companies, as well as wholesalers, manufacturers, retailers and advertising agencies," "major entertainment entities," "emerging technology companies," and "[n]on-profit organizations." None of the firms named on applicant's "Our Clients" list, however, appears on registrant's "Representative Client List."

While it is indeed the case that evidence of the absence of any instances of actual confusion over a significant period of time is a *du Pont* factor which is indicative of no likelihood of confusion, such is a meaningful factor only where the record demonstrates appreciable and continuous use by applicant of its mark in the same market(s) as those served by registrant under its mark. See, e.g., *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In particular,

there must be evidence showing that there has been an opportunity for incidents of actual confusion to occur. See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000).

Here, however, there is no such evidence. Clearly, the mere assertion by applicant's counsel of no incidents of actual confusion in a seven-year period is not evidence. Nonetheless, even if the claimed absence of any instances of actual confusion had been properly proven, the website excerpts indicate in any event that registrant seems to be a relatively small business with a narrow and distinct client focus on environmental science and business development interests in the federal procurement contract marketplace, while applicant actually operates in entirely different fields. It thus is plain that the claimed lack of any known instances of actual confusion is without any probative value with respect to the issue of likelihood of confusion inasmuch as there apparently has been no actual use by registrant of its mark in connection with services of the kinds rendered by applicant and vice versa, notwithstanding that, as indicated previously, applicant's and registrant's services must be treated, in view of the broad manner in which they are respectively identified in the application and cited registration, as legally identical in part and otherwise commercially related for purposes of assessing whether there is a likelihood of confusion. Nevertheless, to the extent that the asserted coexistence of applicant's "THE LEVERAGE GROUP" mark for its services with registrant's "LEVERAGE ENTERPRISES" mark for

its services may serve to create any possible doubt as to whether the former is likely to cause confusion with the latter, we resolve such doubt, as we must, in favor of the cited registrant. See, e.g., In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); and In re Pneumatiques Caoutchouc Manufacture et Plastiques Kelber-Columbes, 487 F.2d 918, 179 USPQ 729, 729 (CCPA 1973).

We accordingly conclude that customers who are familiar or acquainted with registrant's "LEVERAGE ENTERPRISES" mark for "business management consultation, market research analysis and strategic business planning" services" would be likely to believe, upon encountering applicant's substantially similar "THE LEVERAGE GROUP" mark for "business marketing consulting services in the nature of promoting the goods and services of others by creating strategic partnerships between entertainment entities and business entities and arranging for sponsorships between entertainment entities, business entities and entities seeking to promote public causes," that such identical in part and otherwise commercially related services emanate from, or are sponsored by or associated with, the same source.

Decision: The refusal under Section 2(d) is affirmed.